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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/716,918	11/20/2000	Jay S. Walker	98-010X	9324

7590 10/01/2004
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EXAMINER

MOSSER, ROBERT E

ART UNIT	PAPER NUMBER
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3714

DATE MAILED: 10/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/716,918

Applicant(s)

WALKER ET AL.

Examiner

Robert Mosser

Art Unit

3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 50-77 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 50-77 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION



This action is non-final.

Claims 50-77 are pending.

In response to RCE entered July 28th, 2004.



Terminal Disclaimer

The terminal disclaimer filed on 6-28-2004 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of 6,203,430 has been reviewed and is NOT accepted.

An attorney or agent, not of record, is not authorized to sign a terminal disclaimer in the capacity as an attorney or agent acting in a representative capacity as provided by 37 CFR 1.34 (a). See 37 CFR 1.321(b) and/or (c).

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 50-77 rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1-44 of U.S. Patent No. 6,203,430. Although the conflicting claims are not identical, they are not patentably distinct from each other.

Nonetheless, the limitations of the instant claims including a method and a gaming device with a processor that tracks and counts the occurrence of a tracked symbol', increments or decrements the count value associated with the occurrence of the tracked symbol and associates an expiration condition and bonus payout based on the occurrence of the tracked symbol are taught by the claims of US 6,203,430.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim **57** is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim **57** recites the limitation "the slot machine" in line 3. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims **50-53, 57-58, 60-61, 65, 71-77** are rejected under 35 U.S.C. 102(b) as being anticipated by Forte (US 5,586,766).

Regarding claims **50-53, 74-76** Forte teaches a Black Jack game system including the generation an outcome represented by a plurality of symbols (playing cards), tracking the number of player natural Black Jack hands (at least one tracked symbol), and determining a bonus payout (jackpot) based on the number of occurrences of player Natural black Jack hands. The game system of Forte counts consecutive hands (an integer valued count as claimed) and expires or resets the count during the occurrence of a player hand not qualified as natural Black Jack. Once the count has reached a predetermined number in accordance with the number of

consecutive player Black Jack hands the player is awarded the jackpot (Abstract; Col 3:49-57; Col 14:52-16:36).

Regarding claims **52** and **53**, the occurrence of a player hand not qualified as a natural Black Jack the counter is reset and so expires at the time of this occurrence.

Regarding claim **57**, **58**, **65**, **71-72** and **77**, the game of Forte is taught in a slot machine embodiment (Figure 22) and the bonus payout is determined by a number of consecutive hand as set forth above and understood to time dependent as claimed in at least claim **58** as they must be consecutive.

Regarding claim **60**, Forte teaches that eligibility for the jackpot prize may be determined by the player bet or wager amount (Col 16:33-36).

Regarding claim **61**, Forte teaches the use of natural Black Jack hands for incrementing the counter and non-natural Black Jack hands for resetting or decrementing the counter as claimed and shown above.

Regarding claim **73**, Forte teaches the use of the counter value during play (Col 4:29-53) while the specific operation of initializing player counter values halting the recording process after the players conclusion of play are considered inherent features of a game count process.

Claims **50**, **54**, and **65-70** are rejected under 35 U.S.C. 102(e) as being anticipated by Mathis (US 6,053,813).

Mathis teaches a reeled slot machine (Figure 1) the tracking of game out comes comprising a series of symbols and the determination of a bonus payout in accordance

with a series of consecutive wins or losses (Col 2:49-57). Mathis further teaches the inclusion of video poker type games (Col 17:14-26).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims **55, 56, 59**, and **62-64** are rejected under 35 U.S.C. 103(a) as being unpatentable over Forte (US 5,586,766).

Regarding claims **55, 56**, and **59**, Forte teaches the use of player tracking cards (Col 14:61-15:2), and the interconnection of multiple games (Col 3:54-57) but is silent regard the storing of count data on a server, or player tracking card. It would have been obvious to one of ordinary skill in the art at the time of invention to store the count data on a player tracking card or server in order to allow jackpot prizes for play sequences requiring multiple sittings to acquire

Regarding claims **62** and **63**, Forte is silent regarding the use of a multiplier bonus game type or the use of points for a slot play reward system. However the use of multipliers in bonus games and the awarding of frequent play points or comps are old and well known in gaming. It would have been obvious to one of ordinary skill in the art at the time of invention to have incorporated a multiplier bonus in order scale jackpot payouts and/or alternatively utilize bonus's to incorporate slot play points as a the bonus payout in order to give the player the impression of larger payouts.

Regarding claim **64**, Forte teaches the use of a zero payout for expired symbols as set forth above.

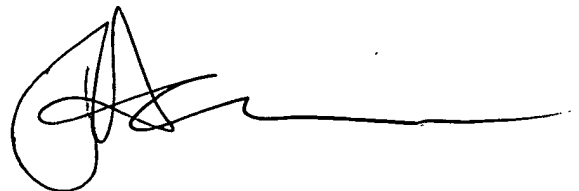
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Mosser whose telephone number is (703)-305-4253. The examiner can normally be reached on 8:30-4:30 Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris H Banks can be reached on 703-308-1745. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

RM

A handwritten signature in black ink, consisting of a large, stylized 'J' followed by a horizontal line and a small flourish.

JESSICA HARRISON
PRIMARY EXAMINER